Supreme Court, U.S.
FILED
AUG 19 1998
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No. 98-62

In The

# Supreme Court of the United States

October Term, 1997

ETHICON, INC. and InBAE YOON, M.D.,
*Petitioners,*

*vs.*

UNITED STATES SURGICAL CORPORATION
and YOUNG JAE CHOI,
*Respondents.*

*On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit*

## RESPONDENTS' BRIEF IN OPPOSITION

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## QUESTIONS PRESENTED

1. Should this Court depart from its normal practice and consider an issue raised for the first time in a petition for rehearing in the Court of Appeals?

2. Does Federal Rule of Civil Procedure 19 require federal courts to ignore the long-standing and settled patent law rule that all patent co-owners ordinarily must consent to and join in an action for patent infringement?

## STATEMENT PURSUANT TO RULE 29.6

Respondent United States Surgical Corporation is a publicly-held company and has no parent companies or nonwholly owned subsidiaries.

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## STATEMENT OF THE CASE

Petitioner Yoon and his licensee, petitioner Ethicon, Inc. ("Ethicon"), brought an action in the United States District Court for the District of Connecticut claiming that respondent U.S. Surgical Corporation ("U.S. Surgical") had infringed a patent issued to Yoon on a safety trocar used for endoscopic surgery. U.S. Surgical, along with respondent Choi as an intervenor-defendant, moved to dismiss on the ground that Choi was a co-inventor who had not consented to the suit and who, in fact, had licensed U.S. Surgical to produce the invention. Petitioners stated to the District Court their concern that if Choi were found to be a co-inventor, then under settled case law their suit would have to be dismissed. C.A. App. 4961, 4964. Petitioners did not move to have Choi involuntarily joined or realigned as a plaintiff.

### A. The District Court's Findings and Dismissal

The District Court conducted a twelve-day evidentiary hearing, after which it found that respondents had proven Choi to be a co-inventor of two of the patent's claims. The District Court's 120 findings of fact included findings that:

1. Choi had conceived the idea for and was the co-inventor of two of the claims of the patent. Pet. App. 75a-76a, 81a, 87a-88a.

2. Yoon had applied for and obtained the patent in his sole name without informing Choi, after leading Choi to believe that Choi's work had been of no value. Pet. App. 59a-60a, 62a.

3. Yoon had altered and backdated documents to make himself appear the sole inventor and to defeat Choi's co-inventorship claim. Pet. App. 67a-71a.

4. Yoon had falsely testified at his deposition about Choi and his contributions. Pet. App. 65a-66a.

5. Choi was a credible witness, and Yoon was not. Pet. App. 70a.

The District Court accordingly granted respondents' motion to correct the patent to name Choi as a co-inventor. Pet. App. 102a. The court then dismissed the action because

> it is well-settled that, in the absence of an agreement to the contrary, one co-owner of the patent cannot sue a third party for infringement unless all other co-owners of the patent voluntarily join the suit.

Pet. App. 43a.

The court noted that although petitioners contended that Choi could have been involuntarily joined as a plaintiff under Federal Rule of Civil Procedure 19(a) ("Rule 19(a)") (which they never moved to do), they "do not deny that, as a matter of substantive law, the co-owner of a patent cannot sue for infringement without the consent of all other co-owners." Pet. App. 44a n.1. The court added that "[e]quity will not aid a wrongdoer whose predicament is of his own making, as Yoon's is here." Pet. App. 43a.

**B. The Affirmance by the Court of Appeals**

On appeal, petitioners challenged the sufficiency of the evidence to support the findings, the admissibility of Choi's testimony, and the District Court's construction of the license agreement. Pet. App. 4a-5a. Petitioners also argued that Choi's license to U.S. Surgical could not grant a release from pre-license infringement. *Id.*

The Court of Appeals for the Federal Circuit, in an opinion by Judge Rader, affirmed. It held that the District Court's findings of fact were not clearly erroneous, that Choi's testimony was admissible and corroborated, and that the evidence supported the finding that Choi was a co-inventor of two of the patent's claims and was, therefore, a co-owner of the patent. Pet. App. 17a, 19a-20a. The court also held that as a matter of Connecticut contract law the District Court had correctly interpreted the scope of Choi's license to U.S. Surgical. Pet. App. 19a-22a.

With respect to the provision of the license that released U.S. Surgical from liability for any alleged infringement prior to the

date of the license, the Court of Appeals agreed with petitioners that under its prior decisions, such a release was not effective because Yoon, as a co-inventor, had not agreed to it. Pet. App. 22a-25a. Nevertheless, the court held that petitioners could not maintain a suit for infringement because of the long established rule of patent law that all the owners of a patent must join as plaintiffs in an infringement suit. Pet. App. 25a (citing *Waterman v. Mackenzie*, 138 U.S. 252, 255 (1891), and *Moore v. Marsh*, 74 U.S. (7 Wall.) 515, 520 (1868)).

Judge Newman dissented. She agreed that "the district court's finding as to the two claims [that Choi was a co-inventor] is not clearly in error." Pet. App. 29a. Her opinion argued, however, that the rule requiring all owners to join as plaintiffs often was inequitable, particularly after the 1984 amendments to the patent code allowed co-inventorship to be based upon contributing to fewer than all of the claims of a patent. Pet. App. 29a-37a. She observed that "Mr. Choi . . . would not pass the pre-1984 test of joint invention," Pet. App. 36a, and expressed concern that the established rule that all owners must join as plaintiffs in an infringement suit had created "a distortion." Pet. App. 37a. She concluded that "legislators surely did not intend to create another inequity," even though "I have come across no discussion of this anomaly in various scholarly articles." Pet. App. 35a. Petitioners do not ask this Court to review this issue, which was the principal basis of Judge Newman's dissent.

In a concluding paragraph, Judge Newman added that as she (unlike the majority) understood a recent Federal Circuit holding, *Schering Corp. v. Roussel-UCLAF SA*, 104 F.3d 341 (Fed. Cir. 1997), a co-owner of a patent was not an indispensable plaintiff to an infringement action, and in any event Choi could have been joined as an involuntary plaintiff under Rule 19(a) if petitioners had so moved. Pet. App. 37a-38a.

**C. The Petition for Rehearing**

Petitioners sought rehearing and rehearing *en banc*. Their petition argued that the Federal Circuit had misconstrued its

*Schering* opinion by holding that infringement suits required the consent of all co-owners unless, as in *Schering*, there had been a prior contractual authorization to sue. Following eight pages of discussion of *Schering*, the petition for rehearing added a separate argument that the Court of Appeals should have applied the factors stated in Federal Rule of Civil Procedure 19(b) ("Rule 19(b)"), rather than the substantive patent law, in determining whether Choi's refusal to consent to and join as a plaintiff in petitioners' action required its dismissal. In so arguing, petitioners cited for the first time *Provident Tradesmens Bank & Trust Co. v. Patterson*, 390 U.S. 102 (1968), which held that "judge-made doctrines of compulsory joinder" were subject to Rule 19(b). 390 U.S. at 118 n.3. Rehearing was denied. Pet. App. 39a.

## REASONS FOR DENYING THE WRIT

Petitioners ask this Court, in a case with an unusual factual record, to decide an issue never addressed by the Court of Appeals and not advanced in that court until the petition for rehearing. The position petitioners ask the Court to adopt, moreover, would be contrary to this Court's decisions; contrary to the Rules Enabling Act, 28 U.S.C. § 2072; and contrary to more than a century of established patent law, reenacted by Congress on several occasions.

### I.

### THE QUESTIONS PRESENTED WERE NOT RAISED OR DECIDED IN THE COURTS BELOW

It is axiomatic that "[w]here issues are neither raised before nor considered by the Court of Appeals, this Court will not ordinarily consider them." *Pennsylvania Dep't of Corrections v. Yeskey*, 118 S. Ct. 1952, 1956 (1998) (quoting *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 147 n.2 (19[illegible]); [illegible], *e.g.*, *Edwards v. United States*, 118 S. Ct. 1475, [illegible] (failure to raise in district court); *Bendix Autolite Corp. v. Midwesco Enters., Inc.*, 486 U.S. 888, 895 (1988) (failure to raise until reply brief); *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 362 (1981); *Duignan v. United States*, 274 U.S. 195, 200 (1927).

Petitioners' argument in the District Court and in their appellate briefs was that Choi could be joined as an involuntary plaintiff pursuant to Rule 19(a). Petitioners now ask this Court to grant certiorari and hold that Rule 19(b) supersedes long-established substantive requirements of the patent law that require dismissal of this case because Choi, a patent co-owner, has not consented to suit and joined as a plaintiff. Yet, petitioners made no such claim to the Court of Appeals until their petition for rehearing. The Court of Appeals' opinion had no occasion to consider that contention and never addressed it. Even the dissenting judge, whose opinion contained a passing reference to the involuntary joinder provisions of Rule 19(a), Pet. App. 37a-38a, never advanced or considered the arguments invoking Rule 19(b) to avoid dismissal that petitioners now attempt to make here. This Court declines to consider questions raised for the first time on rehearing in the court of appeals. *E.g.*, *Hoover v. Ronwin*, 466 U.S. 558, 574 n.25 (1984).

Moreover, petitioners waived their current argument by affirmatively taking precisely the contrary position in the District Court. Not only did they never move to make Choi a plaintiff, they vehemently urged the District Court not to find Choi a co-inventor because, as they recognized:

> If Mr. Choi succeeds in selling his story that he is a co-inventor of any of these claims, USSC, nevertheless, will escape liability under the '773 Patent.

C.A. App. 4964. They acknowledged that a co-inventorship finding would cause dismissal of petitioners' infringement claims. C.A. App. 4961.[1] And that is exactly what the Court of Appeals held.

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1. The District Court similarly observed — prior to the evidentiary hearing — that the motion to have Choi declared a co-inventor "might be dispositive." C.A. App. 4967.

## II.

## THE DECISION IS CORRECT

### A. The Decision Applies Well-Established Holdings of This Court

Even if petitioners had preserved their current argument, there would be no basis for certiorari. The Federal Circuit simply followed well-established law. Petitioners rely principally on a decision of this Court they never cited until after the Court of Appeals' ruling, *Provident Tradesmens Bank & Trust Co. v. Patterson*, 390 U.S. 102 (1968). Petitioners say that *Provident Tradesmens* held that Rule 19(b) supersedes any and all substantive laws requiring joinder of a particular party (in this case, a patent co-owner). *Provident Tradesmens* did not so hold.

In *Provident Tradesmens*, an insurance company sought a declaratory judgment as to its responsibility for damages caused by an automobile driver who was not the insured. The insured could not be joined as a party without defeating diversity jurisdiction. The Third Circuit observed that the insured had an interest in the outcome of the litigation because, if his insurance policy were used to pay a judgment against the driver, the funds available to compensate the insured for any potential judgment against him arising from the accident would be diminished. The Third Circuit thus found the insured to be an "indispensable party" and dismissed the action.

Presented with these facts, this Court in *Provident Tradesmens* did not hold, as petitioners maintain, that Rule 19 supersedes substantive law requiring the consent and joinder of a party. Rather, the Court concluded that there was no *independent* "substantive right" for potentially interested persons to participate in litigation. According to the Court, the cases relied upon by the Third Circuit merely created a general procedural rule favoring joinder of persons likely to be affected by the outcome of a suit

— a general procedural rule that was superseded by Rule 19.[2] The Court did not suggest that where relevant substantive law requires the consent and joinder of a party, Rule 19 could override such substantive law and compel a contrary result:

> The decision whether to dismiss (i.e. the decision whether the person missing is "indispensable") must be based on factors varying with the different cases, *some such factors being substantive*, some procedural, some compelling by themselves, and some subject to balancing against opposing interests.

*Provident Tradesmens*, 390 U.S. at 119 (emphasis added).

In sharp contrast to the situation in *Provident Tradesmens*, substantive patent law long has required the consent and joinder of patent co-owners in infringement suits.[3] The Federal Circuit

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2. Specifically, the Court found:

> The majority of the Court of Appeals read *Shields v. Barrow* [17 How. 130] to say that a person whose interests "may be affected" by the decree of the court is an indispensable party, and that all indispensable parties have a "substantive right" to have suits dismissed in their absence. We are unable to read *Shields* as saying either. It dealt only with persons whose interests must, unavoidably, be affected by a decree and it said nothing about substantive rights.

*Provident Tradesmens*, 390 U.S. at 125. Here, Choi's "substantive right" derives not from general joinder principles, as did the insured's purported "right" in *Provident Tradesmens*, but, rather, originates in the patent laws themselves. *See* Pet. App. 26a (citing 35 U.S.C. § 262).

3. *See* 8 Chisum on Patents § 21.03[3][d]; *Waterman v. Mackenzie*, 138 U.S. 252 (1891); *Moore v. Marsh*, 74 U.S. (7 Wall.) 515, 520 (1868); *Gayler v. Wilder*, 51 U.S. (10 How.) 477 (1850); *Schering*, 104 F.3d at 345; *Willingham v. Lawton*, 555 F.2d 1340, 1343-44 (6th Cir. 1977); *Agrashell, Inc. v. Hammons Prods. Co.*, 352 F.2d 443 (8th Cir. 1965); (Cont'd)

acknowledges this requirement's origin in the patent statute itself, noting that "the congressional policy expressed by [35 U.S.C. § 262] is that patent co-owners are 'at the mercy of each other,' " Pet. App. 26a (quoting *Willingham*, 555 F.2d at 1344), and that absent a unilateral right-to-sue agreement, a patent co-owner "would not be able to sue for infringement if its co-owner [] declined to join the suit." *Schering*, 104 F.3d at 344.

Moreover, if one accepted petitioners' contention that Rule 19(b) supersedes the patent law's requirement that all co-owners of a patent must consent to and join in an infringement suit, then a Federal Rule of Civil Procedure would be superseding substantive federal statutory and common law, in plain violation of the Rules Enabling Act's limitation that the Federal Rules "shall not abridge, enlarge or modify any substantive right." 28 U.S.C. § 2072(b); *see Amchem Products, Inc. v. Windsor*, 117 S. Ct. 2231, 2244 (1997); *Sibbach v. Wilson & Co.*, 312 U.S. 1, 9-10 (1941).[4]

Petitioners' fallback argument — essentially that Choi should have been treated as a plaintiff because he had intervened as a

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(Cont'd)

*Switzer Bros., Inc. v. Byrne*, 242 F.2d 909 (6th Cir. 1957); *Hurd v. Sheffield Steel Corp.*, 181 F.2d 269 (8th Cir. 1950); *Eickmeyer v. United States*, 231 U.S.P.Q. 820, 821-22 (Cl. Ct. 1986); *International Bus. Machs. Corp. v. Conner Peripherals, Inc.*, 1994 WL 409493, at *3 (N.D. Cal. Jan. 28, 1994); *Refac Int'l, Ltd. v. Mastercard Int'l, F.W.*, 758 F. Supp. 152, 157 (S.D.N.Y. 1991); *Cilco, Inc. v. Precision-Cosmet, Inc.*, 624 F. Supp. 49, 52 (D. Minn. 1985); *Cilco, Inc. v. Copeland Intralenses, Inc.*, 614 F. Supp. 431, 434 (S.D.N.Y. 1985); *Valutron, N.V. v. NCR Corp.*, 99 F.R.D. 254, 257 (S.D. Ohio 1982); *Tycom Corp. v. Redactron Corp.*, 380 F. Supp. 1183, 1190 (D. Del. 1974); *American Optical Co. v. Curtiss*, 59 F.R.D. 644, 649-50 (S.D.N.Y. 1973); *Holliday v. Long Mfg. Co.*, 18 F.R.D. 45, 47-48 (E.D. N.C. 1955); *Gibbs v. Emerson Elec. Mfg. Co.*, 29 F. Supp. 810, 811 (W.D. Mo. 1939); *Rainbow Rubber Co. v. Holtite Mfg. Co.*, 20 F. Supp. 913, 916-17 (D. Md. 1937).

4. The petition uses ellipses to omit the statutory language quoted above. *See* Pet. 3.

party defendant — is a *non sequitur*, and again does not arise on this record because petitioners made no motion in the District Court to have him joined or realigned as a plaintiff. Quite the contrary; petitioners explicitly acknowledged to the District Court that if Choi were found to be a co-owner, that would be the end of their case. C.A. App. 4961, 4964.

Petitioners ignore that a co-owner's mere presence in an infringement suit is insufficient. The patent law requires not merely *presence*, but *consent* to the suit. The substantive right the patent laws grant to a co-owner is the right to withhold consent. As the Federal Circuit explained, as a "settled principle" and "*as a matter of substantive patent law*, all co-owners must ordinarily consent to join as plaintiffs in an infringement suit." Pet. App. 25a (emphasis supplied).[5]

**B. There Is No Circuit Conflict**

Petitioners claim a conflict with a 1977 Sixth Circuit decision, *Willingham v. Lawton*, 555 F.2d 1340 (6th Cir. 1977). There is no conflict. The Court of Appeals in this case recognized as an "established exception[]" to the rule that all patent owners must consent to suit the situation where one co-owner has contractually authorized another co-owner to sue unilaterally. Pet. App. 25a n.9. *Willingham*, which the Court of Appeals quoted with approval, Pet. App. 26a, applied precisely this exception. *See* 555 F.2d at 1340.[6]

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5. This right allows a co-owner, for example, to prevent an infringement suit that risks having the patent declared invalid. "[E]very patent owner has an interest in keeping the reputation of his patent from the stain of invalidity — an interest which it is proper for a court to recognize." *A.L. Smith Iron Co. v. Dickson*, 141 F.2d 3, 6 (2d Cir. 1944) (L. Hand, J.).

6. District court cases cited by petitioners involved similar unilateral-right-to sue agreements and/or express agreements by the absent patent co-owner allowing suit. *Howes v. Medical Components, Inc.*, 698 F. Supp. 574 (E.D. Pa. 1988); *Catanzaro v. International Tel. &*

(Cont'd)

### C. Judicial Alteration of the Patent Law Is Not Necessary or Appropriate

There is no reason for this Court to accept the invitation, made for the first time in the petition, to reconsider the more-than-century-old patent law doctrine that all co-owners of a patent must consent to the maintenance of an infringement action. See cases cited in note 3, *supra*. The Federal Circuit has had occasion to reaffirm the rule recently not only in the present case, but in *Schering*, 104 F.3d at 344 (co-owner "would not be able to sue for infringement if its co-owners declined to join the suit").

This long-standing substantive rule, Pet. App. 25a, has remained undisturbed through Congress's many amendments to and reenactments of the patent law. *Cf., e.g., Lorillard v. Pons*, 434 U.S. 575, 580 (1978); *Albermarle Paper Co. v. Moody*, 422 U.S. 405, 414 n.8 (1975). Even the dissenting judge in the Federal Circuit acknowledged the problem to be legislative, rather than judicial.[7] Indeed, the comment on this case cited by petitioners recognizes:

> There can be little doubt that the majority's opinion correctly restates the federal patent law as it exists today.

Dale L. Carlson and James R. Barney, *Who Owns What's in Your Patent?*, 5 Intel. Prop. Today at 10 (1998). Accordingly, those attorneys suggest that Congress weigh the competing interests at stake and amend the law as appropriate. *Id.* at 12. If a legislative

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(Cont'd)
*Tel. Corp.*, 378 F. Supp. 203 (D. Del. 1974); *Michaels of Oregon Co. v. Mil-Tech Inc.*, 38 U.S.P.Q. 2d 1060 (D. Ore. 1995). In *Windsurfing Int'l, Inc. v. Ostermann*, 100 F.R.D. 82 (S.D.N.Y. 1983), the putative co-owner had sued in a different jurisdiction.

7. In her opinion, when Congress enacted the 1984 amendments clarifying that co-inventors need not contribute to each patent claim, it should also have addressed the requirement that all patent co-owners must consent to and join in an infringement action. Pet. App. 36a.

change is called for — and the extraordinary conduct of Yoon, which brought about his own predicament, does not provide an attractive demonstration of any need to alter long-established patent law[8] — then arguments should be addressed to Congress, which enacted and reenacted the patent provisions that both courts properly relied on here.[9]

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8. Unlike in this case, where one co-owner deceived the other, the number of instances in which co-owners will not consent to sue for infringement probably will not be great. Petitioners' speculation that infringers may seek out persons falsely to claim co-inventor status, Pet. 25, ignores that one must *be* a inventor, not merely "claim" such status. Because co-inventor status must be: (1) proven by clear and convincing evidence; and (2) independently corroborated, a putative co-inventor bears a heavy burden. In any event, if false claims proliferated Congress could take appropriate action.

9. Petitioners errantly suggest that the decision below is somehow anomalous or contradictory because it reaffirms the principle enunciated in *Schering* that one patent co-owner cannot "release" an alleged infringer from liability to other co-owners for past infringement while, at the same time, holding that Choi can impede petitioners' infringement suit by withholding his consent. Yet, there is nothing novel in one party's being unable to obtain relief because of another person's refusal to consent to sue, *e.g.*, *Scott v. Williams*, 606 S.W. 2d 267 (Tex. Civ. App. 1980) (co-tenant), or because of a defendant's withholding of consent to be sued, *e.g.*, *Seminole Tribe v. Florida*, 517 U.S. 44 (1996). Moreover, as the Court of Appeals explicitly recognized, nothing precludes one patent co-owner from obtaining from his co-owners a contractual right-to-sue unilaterally. Pet. App. 27a. Had Yoon properly named Choi as a co-inventor and obtained from Choi such a contractual, unilateral right-to-sue, petitioners could proceed with their infringement action without again securing Choi's consent (as occurred in *Schering*).

## CONCLUSION

For the reasons stated, certiorari should be denied.

Respectfully submitted,

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